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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,756	03/10/2004	Daniel James Plant	1315-22	4239

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David M. Carter
Carter, DeLuca, Farrell & Schmidt, LLP
Suite 225
445 Broad Hollow Road
Melville, NY 11747

EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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02/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/797,756

Applicant(s)

PLANT, DANIEL JAMES

Examiner

Cheryl Juska

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62-74 and 76-99 is/are pending in the application.
- 4a) Of the above claim(s) 71, 72 and 76-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62-70, 73 and 74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date 09/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 15, 2008, has been entered.

Response to Amendment

2. Applicant's amendment filed on September 15, 2008, has been entered. Claims 62, 73, and 74 have been amended as requested. Additionally, the specification has been amended as requested. Claims 1-61 and 75 have been cancelled. Thus, the pending claims are 62-74 and 76-99, with claims 71, 72, and 76-99 being withdrawn as non-elected.

3. Said amendment is sufficient to overcome the objection to claims 62, 73, and 74 as set forth in section 5 of the last Office Action (Final Rejection mailed 04/19/07). Additionally, the cancellation of claim 75 renders moot the 101 double patenting rejection as set forth in sections 6 and 7 of the last Office Action.

Specification

4. The disclosure is objected to because of the following informalities: The first line of the specification needs to be amended to reflect the proper status and priority of the application. See section 12 below for further details. **Appropriate correction is required.**

Claim Rejections - 35 USC § 112

5. Claim 69 stands rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement as set forth in section 8 of the last Office Action.
6. Applicant has not amended the claim in an attempt to overcome said rejection. Rather, applicant traverses said rejection by asserting Figure 8 and the associated description at pages 9, line 14-page 10, line 5 provides support for the subject matter of claim 69 (Amendment, page 10, 3rd paragraph). The examiner respectfully disagrees.
7. First, to reiterate, claim 69 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which *was not described* in the specification in such a way *as to enable* one skilled in the art to which it pertains, or with which it is most nearly connected, *to make and/or use the invention*. Claim 69 is non-enabled because the specification as originally filed does not teach one skilled in the art how to make the claimed “compressible bubbles” in the upper and lower woven cover layers of the carrier material. Are the “bubbles” created by the construction of the woven structure itself or are said bubbles embossed therein? Or, are said bubbles formed in another manner?

8. Second, it appears applicant has erred in the citation of the specification passage (page 9, line 14 - page 10, line 5), since said citation from the present specification (un-marked version of the substitute specification filed 03/10/04) discusses Figures 4-6 rather than Figure 8. The correct citation should be page 11, line 16 – page 12, line 7.

9. Third, the citation from the specification regarding Figure 8 and its discussion does not enable the subject matter of claim 69. Note the rejection is not a rejection for lack of antecedent basis or support in the specification for the claimed language. Rather, the rejection is made because the specification *does not disclose* to a skilled artisan *how to make* the claimed “compressible bubbles” in the outer woven fabric layers as shown in Figure 8. The specification merely teaches “Hemispherical bubbles 29 are formed in the upper surface 27 and the lower surface 28 which can be axially aligned or offset relative to each other as illustrated.” However, this passage does not explain *how* said bubbles are *formed*. Similarly, the passage “In the case of the carrier shown in Figure 8, the bubbles 29 and the threads 26a therebetween would be filled with the dilatant compound...” does not explain *how* said bubbles are *formed*. Therefore, the 112, 1st paragraph, lack of enablement rejection for claim 69 is maintained.

Claim Rejections - 35 USC § 102

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 62-64, and 73 stand rejected under 35 USC 102(b) as being anticipated by GB 2 349 798 issued to Plant as set forth in section 10 of the last Office Action.

Applicant traverses the anticipation rejection by arguing that the amendment “wherein the resilient carrier supports the dilatant material” is sufficient to overcome the Plant reference (Amendment, paragraph spanning pages 10-11). Specifically, applicant asserts the present invention does not have to be sealed within an envelope to support the dilatant material, as is required by the Plant reference. This argument is unpersuasive since it is not commensurate in scope with the rejected claims. Note applicant’s claim language does not necessarily exclude such a ‘sealed envelope.’ The feature upon which applicant relies (i.e., lack of a sealed structure which encapsulates the carrier in order to stop the dilatant material from running away) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the rejection of claims 62-64, and 73 by Plant stands.

12. Claims 62-64, 73, and 74 stand rejected under 35 USC 102(e) as being anticipated by US 2005/0037189 issued to Palmer et al. as set forth in section 11 of the last Office Action.

Applicant traverses the Palmer rejection by asserting the reference is not available as 102(e) art due to applicant’s effective filing date of September 13, 2001, which is the filing date of the priority documents for PCT/GB02/04209, from which the present application claims priority to (Amendment, page 12, 1st paragraph – page 13, 4th paragraph). Specifically, applicant asserts the present application is a national stage application (i.e., application filed under 35 USC 371) of PCT/GB02/04209 filed September 13, 2002, which claims priority to at least GB 0122082 and GB 0122084, which have a filing date of 09/13/2001 (Amendment, page 12, 3rd paragraph). Applicant notes the originally filed Declaration states the present application is a

national stage application of a PCT application (Amendment, page 12, 4th paragraph).

“Applicant respectfully submits that a clerical error occurred at the time of filing of the present application in which the present application was filed pursuant to 35 U.S.C. 111(a) instead of being filed pursuant to 35 U.S.C. 371.” (Amendment, page 13, 1st paragraph.)

Applicant concludes, since it was their intent to file an application under 35 USC 371 and not 35 USC 111(a), the present application has an effective filing date of 09/13/2001, which antedates the Palmer reference.

This argument is unpersuasive. First, applicant’s *intent* to file an application under 371 does not substantiate applicant’s claim to a priority date of 09/13/2001. While the declaration originally filed with the present application on 03/10/2004 states said application is a national stage of a PCT application, the fact of the matter is that applicant *failed to provide the proper papers for obtaining entry into the national stage*. **Note the requirements set forth in 35 USC 371, 37 CFR 1.491, 37 CFR 1.495, and MPEP 1893, especially MPEP 1893.01(a)(1).** Hence, the status of the application as filed under 35 USC 111(a) is not merely “a clerical error.” As such, the present application can only lay claim to the PCT application as a foreign priority document under 35 USC 119 (a)-(d).

With the intent of claiming such foreign priority, applicant filed on September 15, 2008 a Petition under 37 CFR 1.78(a)(3) and 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority to the PCT application and its GB priority documents. While said petition has been granted (see Petition Decision mailed January 12, 2009), said petition clearly states that while the unintentional delay in claiming priority is accepted, this does not mean that the application is granted said priority (Petition Decision, page 3, 3rd paragraph). Specifically, the petition only

accepts applicant's claim to priority was intentionally delayed past the required time frame set forth in 37 CFR 1.55(a)(1):

In an original application filed under 35 U.S.C. 111(a), the claim for priority must be presented during the pendency of the application, and **within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application**. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply in an application under 35 U.S.C. 111(a) if the application is:

- (A) A design application; or
- (B) An application filed before November 29, 2000. [Emphasis added.]

As noted in said Petition Decision, for the claim to priority to be granted, all the requirements of 35 USC 120 and 365(c), 37 CFR 1.78(a)(1) and (a)(2), 35 USC 119(a)-(d), and 37 CFR 1.55(a)(1) must be met (Petition Decision, page 3, 3rd paragraph). Upon review of these requirement, it is determined that the present application is deficient in at least the requirement of 37 CFR 119(a):

35 U.S.C. 119. Benefit of earlier filing date; right of priority.

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, **if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.** [Emphasis added.]

As stated in the last Office action, section 11, applicant's claim to the foreign priority date of PCT/GB02/04209, namely 09/13/2002, is not granted since a claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on a foreign application that was filed *more than twelve months before* the United States application was filed (03/10/2004). Additionally, without a claim to the foreign priority date of the PCT application, the earlier filed GB applications are also not granted priority. Hence, **the effective filing date of the present application is its filing date of 03/10/2004**. Therefore the Palmer reference is available as prior art under 102(c) and the above rejection stands.

Please note that applicant must amend the first line of the specification to delete the recitation that the present application is a continuing application of the PCT document and its priority to the GB foreign documents, since in fact, the application has not been granted such priority. Additionally, a new corrected oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

13. Claims 62-64, 73, and 74 stand rejected under 35 USC 102(c) as being anticipated by US 6,701,529 issued to Rhoades et al. as set forth in section 12 of the last Office Action.

As with the Plant rejection, applicant argues features which are not presently claimed (Amendment, page 13, 5th paragraph – page 14, 2nd paragraph). The features upon which applicant relies (i.e., dilatant exiting containment without rupture thereof) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the rejection is maintained.

Claim Rejections - 35 USC § 103

14. Claims 65-68 and 70 stand rejected under 35 USC 103(a) as being unpatentable over the cited Palmer reference in view of US 5,589,245 issued to Roell.

Applicant has not presented any new arguments with respect to the 103 rejection (Amendment, page 14, 3rd and 4th paragraphs). As such, said 103 rejection is also maintained.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached at 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cheryl Juska/
Primary Examiner
Art Unit 1794